



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,096	10/03/2003	Thomas Wagner	(Z)01037 PUS	2288

7590 09/24/2004

M. Robert Kestenbaum
11011 Bermuda Dunes NE
Albuquerque, NM 87111

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,096	Applicant(s) WAGNER, THOMAS	
	Examiner Joshua L Pritchett	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 7, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/04</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

This action is in response to Amendment filed August 4, 2004. Claims 1, 5 and 8-12 have been amended as requested by the applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 8-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mai (US 6,005,711).

Regarding claims 1 and 3-5, Mai discloses a sighting telescope comprising an outer tube (12) an inner tube (74) movable transversely of a telescope axis relative to the outer tube; operating elements arranged mutually at an angle for transversely displacing the inner tube (col. 5 lines 22-23; Fig. 1), one or more leaf springs (116) arranged between the outer tube and the inner tube that produces a resorting force on the inner tube (Fig. 3), wherein the leaf spring extends substantially in a radial direction (Fig. 3).

Art Unit: 2872

Regarding claim 6, Mai discloses an optic displaceable in a direction of the telescope axis and an adjustment for displacing the optics arranged in or in the neighborhood of a plane of the operating elements for transversely displacing the inner tube (col. 6 lines 34-37).

Regarding claims 8, 9 and 12, Mai discloses the leaf spring supported at at least three peripherally offset places on the outer tube (col. 5 line 66 – col. 6 line 3). Mai discloses the leaf spring can contain any number of supports.

Regarding claim 10, Mai discloses the two support places of the leaf spring on the inner tube is arranged respectively opposite one of the operating elements for transverse displacement of the inner tube (Fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mai in view of Gibson (US 4,408,842).

Regarding claim 2, Mai teaches the invention as claimed but lacks reference to the outer tube having an enlarged inner diameter. Gibson teaches the outer tube comprising an enlarged

Art Unit: 2872

inner diameter in a region of the operating elements (Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to equip the Mai invention with the enlarged inner diameter of Gibson for the purpose of allowing the inner tube to have a wider range of motion.

Response to Arguments

Applicant's arguments filed August 4, 2004 have been fully considered but they are not persuasive.

On page 6 of Amendment applicant argues that Fig. 3 of Mai shows the leaf spring extending only in the axial direction. Fig. 3 of Mai shows that the leaf spring (116) extends in both the axial and the radial directions. Fig. 3 shows that the leaf spring is connected at the inner wall of the outer tube near element 26 and is extended radially inward to contact the outer wall of the inner tube near element 78.

On page 6 of Amendment applicant argues that there is no enlarged diameter in a region of the operating elements. The term enlarged does not mean the same thing as increasing. The internal diameter at the area of the leaf spring is enlarged with respect to the inner tube. If the applicant wishes to convey the meaning that the outer tube is increasing in size the applicant may wish to use "increasing" instead of enlarged or to better define to what relative element the outer tube is enlarged.

Applicant's arguments, see Amendment, filed August 4, 2004, with respect to claim 7 have been fully considered and are persuasive. The rejection of claim 7 has been withdrawn.

Allowable Subject Matter

Claims 7, 11 and 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and the objection for minor informalities overcome.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 7, the prior art of record fails to teach or suggest the claimed relationship between the internal and external diameters of the outer tube.

Regarding claims 11 and 13, the prior art of record fails to teach or suggest the claimed relationship between the different supports of the leaf spring.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2872

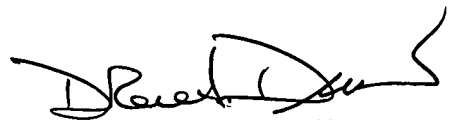
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 


DREW A. DUNN
SUPERVISORY PATENT EXAMINER